

REMARKS

Applicants respectfully request reconsideration and allowance of the above-identified patent application. Claims 1-37 remain pending, wherein claims 1, 16, 28, and 34 are independent claims and claims 1, 5, 7, 11-13, 15-21, 24, and 28-37 have been amended.¹

Initially, Applicants and Applicants' attorney express appreciation to the Examiner for the courtesies extended during the recent interview held on April 19, 2006. The claim amendments and arguments submitted in this paper are consistent with the amendments and arguments presented during the course of the interview.

In the Office action, claims 28-37 are rejected under 35 U.S.C. § 101 as allegedly not limited to tangible embodiments. In particular, the Office action alleges that in view of Applicants' disclosure the computer-readable media is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., RAM, CD-ROM) and intangible embodiments (e.g., connection to either hardwired, wireless, or a combination of hardwired or wireless, any such connection is properly termed a computer-readable medium). In the interest of expediting prosecution of the current application, Applicants have amended the specification and claims in accordance with suggestions from the Examiner.² Accordingly, Applicants respectfully request withdrawal of this ground of rejection.

¹ Support for the claim amendments can be found throughout the specification; for example, support may be found in the following paragraphs: [0030], [0034], [0035], [0038], and [0039].

² Nevertheless, Applicants reserve the right to further challenge this ground of rejection by way of presenting corresponding claims that define the computer readable medium in terms consistent with the breadth of that term as provided in Applicants' specification in any related application, as deemed appropriate by Applicants.

Applicants respectfully submit that there is sound policy reasons why a signal, carrier wave or "connection" used to provide software to users should be treated no differently for purposes of patent eligibility than a computer disc such a CDROM or floppy disk. On a strictly factual basis it is highly questionable whether a signal, carrier wave or other connection is not "tangible". Simply because one cannot see or touch the medium does not change the reality that such a medium nonetheless is real and is used every day to transmit and download software just as effectively as software contained on a CDROM. Thus, to deny patent eligibility for such claims is to ignore the reality that such media is most certainly employed in the using and selling of software carried by such a medium, and thus denies claims to a patent owner that would otherwise provide a basis for asserting direct infringement against competitors, thereby relegating such subject matter to assertions of indirect infringement only, with no sound policy basis for doing so. In other words, to deny such computer program products of patent protection on this basis appears to be exalting form over substance.

Moreover, the asserted reason for treating so-called "signal" claims differently from other kinds of computer readable media (e.g., that wireless signals or connections are not tangible, and cannot tangibly embody a computer program or process since a computer cannot understand/realize (i.e. execute) the computer program or process when embodied or carried on the data signal or connection) is equally as true for other media such as discs or CDROMs. Executable instructions on a disk or CDROM, like those carried by a signal or connection, also cannot be understood or executed until those computer-executable instructions are off-loaded from the disk or

Next, the Office action objects to claims 5, 7, 30, and 31 for various informalities. Accordingly, these claims have been amended as suggested in order to address the Examiner's concerns. Therefore, Applicants respectfully request withdrawal of these grounds of rejection.

Further, the Office action rejects the independent claims under 35 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent Publication No. 20030140138A1 to Dygon et al. ("*Dygon*"). The remaining dependent claims are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by *Dygon* or under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Dygon* in view of U.S. Patent No. 6,223,306 to Silva et al. ("*Silva*") and/or further in view of U.S. Patent Publication No. 2004/0250243A1 to Banerjee et al. ("*Banerjee*").³ Applicants respectfully traverse these grounds of rejection.

As discussed during the interview, Applicants' invention generally relates to a testing system configured to consistently evaluate test results across multiple testing environments. As will be appreciated, due to inevitable differences in components of each test environment, a particular test will often produce different resulting outputs. For example, when testing a software object in a computing system there often exists differences in components—both hardware (e.g., processing speeds and type, memory size and type, etc.) and/or software (e.g., application, operating system, etc.)—that will inevitably produce different results for a single test. As such, the test program may inappropriately indicate that the software object is not operating as intended. Accordingly, a test developer will often be required to create or maintain instructions for each test program. Moreover, as new environments are developed as a result of technological advances, the developer may also be required to develop additional instructions for these new environments, which can be a rather onerous process.

In order to overcome problems noted above, Applicants advantageously provide for consistent evaluation of an object across multiple testing environments without having to generate or maintain new or additional test instructions for each environment. For example, as recited in independent method claim 1, embodiments provide for receiving actual test results, the

CDROM into the computer's RAM. This is no different for a carrier signal or connection, and hence the asserted factual distinction as to tangibility simply lacks merit.

³ Although the prior art status of the cited art is not being challenged at this time, Applicants reserve the right to challenge the prior art status of the cited art at any appropriate time, should it arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited art.

actual test results being generated as a result of performing a test in a test environment. Environmental data is also received that defines the test environment under which the actual test results are generated. In response to the received environmental data, expected test result(s) are received from a results retrieval sub-system that includes expected test results for the same test executed in different test environments. Note that each of the expected test results are keyed by environmental conditions representing a particular test environment for comparing with the received environmental data when attempting to find a match therewith. Then, the actual test results are evaluated against the selected expected test result(s) to determine if the test was successfully performed in the test environment.

Claim 16 recites a method for creating consistent evaluation of the object across multiple testing environments without having to generate or maintain new or additional test instructions for varying environments by retrieving expected results that are to be used to determine the successfulness of a test. Similar to above, environmental data is received that defines a test environment under which actual test results are generated indicating that a test was performed in the test environment. In response to the received environmental data, expected test result(s) are received from a results database that includes a plurality of expected test results for the same test executed in different test environments. The selected expected test result(s) are then sent to a results evaluation sub-system in response to receiving the environmental data, wherein each of the expected test result(s) are keyed by environmental conditions representing particular test environment(s) for comparison with the received environmental data when attempting to find a match therewith.

As discussed and generally agreed to during the interview, the cited art fails to anticipate or make obvious the claimed invention. In particular, the cited alleged prior art does not disclose, suggest, or enable each and every element of Applicants' claimed invention.⁴ For

⁴ "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131. That is, "for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly." MPEP § 706.02. Applicants also note that "[i]n determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure.'" MPEP § 2121.01. In other words, a cited reference must be enabled with respect to each claim limitation.

In order to establish a *prima facie* case of obviousness, "the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP § 2143 (emphasis added). In addition, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one

example, *Dygon*, *Silva*, and/or *Banerjee*—taken either individually, or as a whole—do not disclose or suggest a testing system that includes expected test results for the same test executed in different test environments, which are keyed by environmental conditions representing particular test environment(s) for comparison with received environmental data when attempting to find a match therewith, as recited, *inter alia*, in claims 1 and 16.

Dygon discloses a remotely driven system for multi-product and multi-platform testing. Although *Dygon* discloses a series of databases that are used to generate test results for different products across multiple platforms, the databases need to include the appropriate parameters, product descriptions, commands, and other data objects in order to appropriately evaluate results. In other words, similar to the deficiencies of current testing mechanisms described above, *Dygon* modifies executable code and other parameters based on new definitions, products, platforms, etc. in order to generate results that can be compared to expected results. See e.g., *Dygon* pars. [0031], [0036]–[0039], [041], and [0042]. Accordingly, *Dygon* cannot possibly disclose (or suggest) a testing system that includes expected test results for the same test executed in different test environments, which are keyed by environmental conditions representing particular test environment(s) for comparison with received environmental data when attempting to find a match therewith, as recited, *inter alia*, in claims 1 and 16. In fact, as discussed during the interview, because *Dygon* discloses the need for modifying execution code and parameters for updating environmental conditions, *Dygon* actually teaches away from Applicants' claimed invention.

Noting some of the deficiencies of *Dygon*, the Office action cites both *Silva* and *Banerjee*. *Silva* discloses a method and apparatus for testing "X" servers; *Banerjee* discloses testing subsystems on platforms for software applications. As noted above, the Office action relies on *Silva* and *Banerjee* for allegedly disclosing various features within some of the dependent claims. Accordingly, Applicants respectfully submit that neither *Silva* nor *Banerjee*—taken either individually or as a whole—rectify those deficiencies noted above with regard to

or ordinary skill in the art, to modify the references or to combine reference teachings. MPEP § 2143. During examination, the pending claims are given their broadest reasonable interpretation, i.e., they are interpreted as broadly as their terms reasonably allow, consistent with the specification. MPEP §§ 2111 & 2111.01. Finally, Applicants note that M.P.E.P. §2141.02 states that the cited references must be considered as a whole, including those sections that "teach away" from the claimed invention. (Citation omitted).

Dygon. Accordingly, Applicants respectfully submit that the combination of the cited art of record does not render independent claims 1 or 16 unpatentable.

Applicants respectfully note that independent claims 28 and 34 recite computer program products with elements similar to those noted above with regard to claims 1 and 16. As such, Applicants respectfully submit that claims 28 and 34 are patentably distinguishable over the cited art of record for at least those reasons stated above with regard to claims 1 and 16; and therefore, Applicants respectfully request withdrawal of these grounds of rejection.

Based on at least the foregoing reasons, Applicants respectfully submit that the cited prior art fails to anticipate or make obvious Applicants' invention, as claimed for example, in independent claims 1, 16, 28, and 34. Applicants note for the record that the remarks above render the remaining rejections of record for the independent and dependent claims moot, and thus addressing individual rejections or assertion with respect to the teachings of the cited art is unnecessary at the present time, but may be undertaken in the future if necessary or desirable, and Applicants reserve the right to do so.

All objections and rejections having been addressed, Applicants respectfully submit that the present application is in condition for allowance, and notice to this effect is earnestly solicited. Should any question arise in connection with this application or should the Examiner believe that a telephone conference with the undersigned would be helpful in resolving any remaining issues pertaining to this application, the undersigned respectfully requests that he be contacted at +1.801.533.9800.

Dated this 13th day of June, 2006.

Respectfully submitted,



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